

The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN M. GIOMETTI

Appeal No. 2004-0436
Application 09/746,251

ON BRIEF

Before PAK, WARREN and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 5. Appellant states that “[t]his appeal involves claim 1” (brief, page 2). Accordingly, we dismiss the appeal with respect to claims 2 through 5, and consider only appealed claim 1 which reads as follows:

1. A glass container inspection machine comprising a star wheel carrier assembly including
a vertical rotatable shaft,
upper and lower hub assemblies mounted on said vertical rotatable shaft having
a central hub portion, and
an annular outer supporting portion,
three identical carrier segments arranged in side by side relation to form an annular carrier, each having a plurality of bottle receiving pockets and a partial pocket at either end

thereof which, with a partial pocket of an adjacent segment forms a complete bottle receiving pocket, and

releasable fastener means for securing said three identical carrier segments on said annular outer supporting portion.

Appealed claim 1 is drawn to a glass container inspection machine comprising at least a star wheel carrier assembly including at least the components specified in the claim, wherein the star wheel has “three identical carrier segments arranged in side by side relation to form an annular carrier, each having a plurality of bottle receiving pockets and a partial pocket at either end thereof which, with a partial pocket of an adjacent segment forms a complete bottle receiving pocket.” According to appellant, “each edge of each ring portion[, that is, carrier segment,] can end with a half pocket” (brief, page 4; *see* specification, e.g., page 3, lines 22-25, describing **FIG. 2**).

The reference relied on by the examiner is:

Kantor	2,370,969	Mar. 6, 1945
--------	-----------	--------------

The examiner has rejected appealed claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Kantor.¹

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellant, we refer to the examiner’s answer and to appellant’s brief for a complete exposition thereof.

Opinion

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported position advanced by the examiner (Paper No. 8, pages 2-3; answer, pages 2-3) that, *prima facie*, the design of the two carrier segments of star wheel **43** in Kantor **Fig. 1**² described at page 2, left column, lines 27-32, each segment of which identically having a partial pocket at each end thereof, would have reasonably motivated one of ordinary

¹ The examiner refers to the Office action mailed September 26, 2002 (Paper No. 8) for a statement of the ground of rejection (answer, page 2). We find that the “attached marked up drawing figure of Kantor” referred to in Paper No. 8 is attached to the Office action mailed January 24, 2002 (Paper No. 5) wherein the same statement of the ground of rejection appears.

skill in this art to use additional identical segments of the same design to provide more bottle pockets in the reasonable expectation of accommodating the desired number and size of the bottles to be conveyed.

Accordingly, since a *prima facie* case of obviousness has been established over Kantor by the examiner, we have again evaluated all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellant's arguments in the brief. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)

As pointed out by the examiner, the two carrier segments of star wheel **43** in Kantor **Fig. 1** are identical, and each has three full bottle pockets and a half bottle pocket on each end, so that together, the two segments of the star wheel accommodate eight bottles. We find that the position of the examiner is that the concept of a segmented star wheel wherein the segments are of identical design, including a half pocket at each end, was known in the art as shown by Kantor and the use of more than two identical segments following the same segment design, concentrically arranged on an outer annular portion around a hub to form a star wheel carrier in order to accommodate different numbers of bottles and sizes thereof, would thus have been reasonably suggested to one of ordinary skill in this art from the drawing of segmented star wheel **43** in Kantor **Fig. 1** alone (Paper No. 8, pages 2-3; answer, pages 2-3).

Appellant argues that "the direction of the art is clear (two piece star wheel) and does not suggest applicant's invention (a three piece star wheel)" (brief, page 5). Appellant contends that in segmented star wheel **43** in Kantor **Fig. 1**, "the star wheel portions extend inwardly to the central shaft and the entire star wheel has to be dismantled for service or change" while "[i]n the claimed invention annular pocket segments rather than the entire star wheel portions are replaced" (*id.*). Appellant further contends that the language of claim 1 "defines the carrier, not as a wheel or wheel portion extending outwardly from the shaft but merely as annular segments" while in segmented star wheel **43**, "the wheel or wheel portion would include material from these segments radially inwardly to the shaft" (*id.*).

² Kantor **Fig. 1** also shows star wheel **2** in which each of the two carrier segments has a partial pocket at each end thereof, wherein the bottle pockets of the star are reversed from that of star

The examiner responds that segmented star wheel **43** has eight pockets and the desire to convey more than eight bottles “would require at least a three piece star wheel so that there are partial pockets on each piece” such that adjacent pieces will form a pocket (answer, page 2). The examiner further contends that segmented star wheel **43** has “a central hub portion and an outer annular portion with releasable fastener means for connecting” the two carrier segments as required by appealed claim 1 (*id.*, page 3).

A reference can provide the suggestion or motivation to one of ordinary skill in the art to modify the teachings thereof, either expressly or by inference. *See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (“When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted.] This suggestion or motivation need not be expressly stated. [Citation omitted.]”). In this respect, it is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, see *In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

We find that in the marked up sheet of drawings of Kantor attached to the first Office action (Paper No. 5) (*see above* note 1), the examiner identifies the structures of segmented star wheel **43** in Kantor **Fig. 1** that correspond to the limitations in appealed claim 1 which are argued by appellant in the brief without reference to this disclosure of Kantor. On this record, we conclude that one of ordinary skill in this art would have reasonably inferred the meaning of each of the features of the drawing that the examiner ascribes thereto, even though the same is not expressly set forth in Kantor. Therefore, we agree with the examiner that the difference between the claimed apparatus comprising at least a star wheel carrier assembly as defined in appealed claim 1 and segmented star wheel **43** is the number of identical carrier segments, and thus, the dispositive issue in this appeal is whether the disclosure of star wheel **43** in Kantor **Fig. 1** alone

wheel **43** to accommodate machine direction (page 2, left column, lines 23-32).

would have suggested to one of ordinary skill in this art to modify star wheel **43** by using more than two identical carrier segments of the design shown therein.

In this respect, as we noted above, appellant points to the difference in the number of identical carrier segments, stating that Kantor does not show the claimed “three piece star wheel” (brief, page 5). Appellant does submit, in summarizing the invention, that in the “current commercial environment,” two piece star wheels for nine pockets, the segments are not identical and thus undesirable, relying on this contention in alleging that the art is following the old two segment design even with its undesirable consequences (*id.*, pages 3 and 5; *see also* specification, pages 1-2). The examiner points out that “[a] mere duplication of parts does not appear to provide a patentable departure from that of Kantor” because “[t]he number of bottle receiving pockets would depend on design choices of the system being utilized” (Paper No. 8, page 3).

“It is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced” *In re Harza*, 274 F.2d 669, 671, 124 USPQ 378, 380 (CCPA 1960). On this record, we agree with the examiner that one of ordinary skill in this art would have been motivated by the disclosure of identical segments for star wheel **43** in Kantor **Fig. 1** to use additional identical carrier segments of the design shown therein modified to suit the number of bottles to be conveyed in a system.

We are not convinced otherwise by appellant’s arguments that one of ordinary skill in the art would not have used three identical carrier segments which can be of the same design as the identical segments of star wheel **43**, that is, a half pocket on each end of the segment, modified with respect to the number of whole pockets to convey more than the eight bottles accommodated by star wheel **43**, for two reasons. First, appellant has not established that Kantor and the additional patent cited (brief, page 3) constitute sufficient evidence to establish the alleged “current commercial environment” with respect to star wheels. *Cf. e.g., In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) (“This court has said . . . that mere lawyers’ arguments unsupported by factual evidence are insufficient to establish unexpected results. [Citations omitted.]”). And second, appellant has not established that one of ordinary skill in this art would not have recognized the problem in the routine use of the known two

segment star wheels conveying nine bottles and thus would not have been motivated to solve it. *See In re Nomiya*, 509 F.2d 566, 574, 184 USPQ 607, 613 (CCPA 1975) (“The significance of evidence that a problem was known in the prior art is, of course, that knowledge of a problem provides a reason or motivation for workers in the art to apply their skill to its solution.”); *In re Ludwig*, 353 F.2d 241, 243, 147 USPQ 420, 421 (CCPA 1965); *In re Goodman*, 339 F.2d 228, 232-33, 144 USPQ 30, 33-34 (CCPA 1964).

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in Kantor with appellant's countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claim 1 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHUNG K. PAK
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

Appeal No. 2004-0436
Application 09/746,251

Spencer T. Smith
Emhart Glass Manufacturing Inc.
89 Phoenix Avenue
P.O. Box 1229
Enfield, CT 06083-1229